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MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C. P.O. BOX 398 AUSTIN, TX 78767-0398			PEIKARI, BEHZAD	
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MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.  
P.O. BOX 398  
AUSTIN TX 78767-0398

TECHNOLOGY CENTER 2100

In re Application of: Ernest Patrick Hanavan III )  
Application No. 10/736,272 )  
Attorney Docket No. 5760-16500 )  
Filed: December 15, 2003 )  
For: SERVER-FREE ARCHIVAL OF )  
BACKUP DATA )

**DECISION ON PETITION TO  
WITHDRAW RESTRICTION  
REQUIREMENT UNDER 37 CFR  
§1.144**

This is a decision on the petition filed August 27, 2007 under 37 C.F.R. §1.144 and 37 C.F.R. §1.181 to withdraw an outstanding restriction requirement.

The petition is **GRANTED**.

**RELEVANT PROSECUTION HISTORY**

December 15, 2003 The application identified above was filed with claims 1-19.

January 3, 2006 A non-final Office action was mailed rejecting claims 1-19.

April 4, 2006 Response was filed with remarks, and no amendments.

June 13, 2006 A final Office action was mailed rejecting claims 1-19.

August 17, 2006 Response requesting reconsideration of final rejection was filed.

August 28, 2006 Advisory action was mailed holding the final rejection of claims 1-19.

September 18, 2006 RCE was filed including amendments to claims 1, 7, 11, 13, 14, and 18.

November 30, 2006 Restriction Requirement was mailed.

December 18, 2006 A paper was filed requesting reconsideration of the restriction requirement.

March 8, 2007 A non-final Office action was mailed rejecting claims 1-19, and making the restriction requirement final.

June 7, 2007      Response filed with amendments to claims 1 and 18.

July 26, 2007      Examiner indicated that application is in condition for allowance except for the presence of non-elected claims in the application. Applicant was given one month to cancel the noted claims or take appropriate action under 37 CFR 1.144.

August 27, 2007      Instant petition filed requesting withdrawal of the restriction requirement.

### **REGULATIONS AND PRACTICE**

#### **37 C.F.R. § 1.143 states:**

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

#### **37 C.F.R. § 1.144 states:**

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Commissioner to review the requirement ... A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

#### **37 C.F.R. § 1.145 states:**

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

#### **37 C.F.R. § 1.181 states:**

- (a) Petition may be taken to the Commissioner:
  - (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination

proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and

(3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

MPEP § 803 states:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

**CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS**

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).... For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02....

MPEP 806.05(d) [R-5] Subcombinations Usable Together states:

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants.

> To support a restriction requirement where applicant separately claims plural subcombinations usable together in a single combination and claims a combination that requires the particulars of at least one of said subcombinations, both two-way distinctness and reasons for insisting on restriction are necessary. Each subcombination is distinct from the combination as claimed if:

- (A) the combination does not require the particulars of the subcombination as claimed for patentability (e.g., to show novelty and unobviousness), and
- (B) the subcombination can be shown to have utility either by itself or in another materially different combination.

See MPEP § 806.05(c). Furthermore, restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search.

**DECISION**

37 C.F.R. § 1.181(c) requires that an action by an examiner, to be properly petitionable, must be followed by a request for reconsideration, and a repeated action by the examiner. 37 C.F.R. § 1.144 states that the applicant may petition the Commissioner after a final requirement for the restriction has been made. The response filed by applicant on 12/18/06, to the restriction requirement mailed on 11/30/2006, and the non-final action mailed by examiner on 3/8/07, making the restriction requirement final, satisfy the above requirements.

The issue presented in the petition is whether the restriction based on characterizing claims as being limited to subcombinations disclosed as usable together, is proper under the current regulations and practice.

MPEP § 803 sets forth two criteria for a proper restriction requirement between patentably distinct inventions: (A) the inventions must be independent or distinct as claimed and (B) there must be a serious burden on the examiner.

Furthermore, restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search.

The two groups of claims, Group I consisting of claims 1-6 and 18-19, and Group II consisting of claims 7-17, are both drawn to backup and archiving in a storage area network, and have overlapping scope. A search for the claimed invention of claim 1 would encompass the features of claim 7, except for the "freezing" and "thawing" of memory. The claim features at issue, the limitation "freezing the backup data to prevent the backup data from being altered" and "after completing the server-free copy, thawing the backup data so that the backup data may again be altered" were present in the original claim 7, presented with the application filed on December 15, 2003, and were searched/examined by the examiner through the FAOM mailed on January 3, 2006, Final Rejection mailed on June 13, 2006, Advisory Action mailed on August 28, 2006. Hence, examiner has failed to provide convincing evidence of serious burden if restriction were not required.

For the above reasons, the petition is **GRANTED**.

The restriction requirement is hereby **WITHDRAWN**.

The application will be forwarded to the examiner for consideration on the merits of claims 1-19.



Mano Padmanabhan  
WQAS, Technology Center 2100  
Computer Architecture, Software, and  
Information Security  
(571) 272-4210